



## ATTACHMENT A REMARKS

Considering the matters raised in the Office Action in the same order as raised, corrected drawings are submitted herewith in compliance with 37 CFR 1.121(d).

Claims 1-18 have been rejected under 35 USC 103(a) as being "unpatentable over" Roth in view of Kiely. This rejection is respectfully traversed.

Roth discloses an Internet advertising system wherein advertisements are provided from a central server to viewers who access websites. The central server stores both advertisements and an information database. Proposed bids are submitted by different advertisers and are evaluated in real-time in order to determine which particular advertisement will be displayed to a viewer. Each proposed bid specifies a price or amount that the advertiser is willing to pay for the opportunity to display an advertisement to a viewer and on a website. Bidding agents compare the characteristics of "view-ops" to the specifications in the proposed bids, and submit bids, as appropriate, to bid selection logic. The latter decides which bid to accept for each particular view-op.

Kiely discloses an upsell system and method for use on the worldwide web. Upsell offers are presented to customers who have placed orders with a website, by a third party upsell server. At or near the completion of the transaction, transaction details are communicated to the third party upsell server. The latter then provides an offer directly to the customer. If the customer accepts the offer, an upsell order is processed by the upsell server in a manner that is said to be "seamless" to the customer. As set forth in paragraph [0027] an "upsell" involves a situation wherein after an order is submitted, but before control of the client system is returned to the customer, a mechanism is implemented to provide an additional or post-sale offer to the customer. The idea is to make a further offer to the customer while the customer is already in a buying mode and thus more likely to accept a further offer.

Turning to the present invention, and considering claim 1 as exemplary, the present invention as claimed in claim 1 relates to a method for providing one or more real-time marketing opportunities to third parties during a sale transaction between a customer and a seller purchasing a product, with the real-time marketing opportunity

being offered by the seller. This is entirely different from Roth wherein proposed bids are submitted by different advertisers completely independent of any particular sale in progress, i.e., without reference to a "sales transaction between a customer and a seller for purchasing a product."

Claim 1, as amended, also provides for "issuing an alert over an established connection to third parties that the sales transaction is in progress and a bidding process is opened for soliciting bids on at least one of the one or more real-time marketing opportunities in question." Claim 1 further provides that one or more bids are received from one or more of the third parties and, as amended, also recites that a determination is made of a winning bid for each of the one or more real-time marketing opportunities included in the bidding process based on the one or more bids received.

It is respectfully submitted that this bidding process clearly distinguishes from the Kiely patent wherein there is no bidding process, but wherein, instead, upsell offers are presented to customers who have placed orders with a website. The upsell offer is made by a single third party upsell server, and, again, there is no involvement in a bidding process by a plurality of third parties. In the latter regard, claim 1 and the other independent claims have been amended to make it clear that the alert is issued to "third parties" (rather than "one or more" third parties) so that the recitation "bidding process" has more meaning (a bidding process, as that term would normally be understood, would not involve only a single bidder).

It is, of course, recognized that the rejection here is based on a combination of the two references and that the rejection cannot be overcome by simply attacking the two references individually. However, it is respectfully submitted that it would not be obvious to combine the Roth and Kiely references in the manner proposed by the Examiner. The Roth patent relates to a relatively straightforward Internet advertising system wherein proposed bids submitted by different advertisers are evaluated and a decision is made as to which bid to accept. The Kiely patent concerns a much different type of system which is exclusively concerned with upsell offers and which has nothing to do with bidding by third parties. In this regard, it is respectfully submitted that the Kiely patent does not disclose issuing an alert over an established connection to multiple third parties that a sales transaction is in progress. Specifically, contrary to the

contention in the Office Action, the abstract in Kiely (to which the Examiner has made reference as disclosing this feature) simply provides that transaction details are communicated to a third party upsell server that provides an offer directly to the customer. As explained in paragraph [0028] of Kiely, in implementing the upsell process, the customer is notified of a post-sale opportunity during the transaction, and the “opportunity” is a notification to the customer that the customer is being given an opportunity to make an additional transaction, e.g., through the use of a pop-up window or an upsell script. Thus, now that claim 1 has been amended to make it clear that the alert is issued to multiple third parties, it is believed clear that no fair combination of the Kiely and Roth patents could result in the present invention as claimed.

Further, applicant respectfully takes issue with the manner in which the claims are being read on the references, i.e., it is respectfully submitted that it is improper to simply read one aspect of the claim on one reference and another aspect of the claim on another reference without establishing a clear basis for combining the references. In this regard, applicant disagrees with the contention that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Roth to have included issuing an alert to third parties (as now specified in the claim) during the sales transaction, as taught by Kiely, in order to provide direct marketing access to customers. It is respectfully submitted that paragraph [0004] cited by the Examiner has nothing to do with this aspect of the invention, and merely discusses, in general terms, the shortcomings of current methods for putting sales offers in front of potential customers in a web setting.

With respect to independent claims 7 and 13, these claims are allowable for basically the same reasons discussed above in connection with claim 1. Similar remarks apply to the dependent claims although it is believed that at least one or more of the dependent claims is separately patentable over the references cited.

Allowance of the application in its present form is respectfully solicited.

**END REMARKS**